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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/849,350

05/19/2004

Hideki Nagino

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EXAMINER

SAVLA, ARPAN P

ART UNIT

PAPER NUMBER

2185

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/849,350	Applicant(s) NAGINO ET AL.	
	Examiner Arpan P. Savla	Art Unit 2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office action is in response to Applicant's communication filed November 16, 2006 in response to the Office action dated June 16, 2006. Claims 2-6 have been amended. Claims 1-6 are pending in this application.

OBJECTIONS

Drawings

1. In view of Applicant's amendment, the objection to the drawings has been withdrawn.

Specification

2. In view of Applicant's amendment, the objections to the specification have been withdrawn.

REJECTIONS NOT BASED ON PRIOR ART

Claim Rejections - 35 USC § 112

3. In view of Applicant's amendment, the 112 rejections to **claims 2-6** have been withdrawn.

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-4 and 6 are rejected under U.S.C. 102(b) as being anticipated by Tanaka (U.S. Patent 6,199,120).**

6. **As per claim 1**, Tanaka discloses a storage device that is detachably attachable to an information processing apparatus, comprising:

an IC chip (col. 14, lines 10-11; Fig. 4, element 1D);

a first control unit extracting a control command for the IC chip included in a control command for the storage device from the information processing apparatus (col. 21, lines 29-36; col. 22, lines 9-18; Fig. 4, elements 2D and 3D; Fig. 13, element 5; col. 27, lines 28-31; col. 28, lines 17-25; Fig. 20, elements 4, 5A, 7A, and 56A). *It should be noted that the "IC card RW apparatus" is analogous to the "first control unit" and the "host" is analogous to the "information processing apparatus." It should also be noted that the IC card processing section "extracts" a converted control command from the IC card command sent from the host via protocol conversion, and then sends the converted control command to the IC card.*

and a second control unit performing interface conversion corresponding to the IC chip on the control command for the IC chip extracted by the first control unit and

giving the converted control command to the IC chip (col. 14, lines 13-20; Fig. 4, element 13D). *It should be noted that the "interface section" is analogous to the "second control unit." It should also be noted that since the IC card RW apparatus performs all read/writes to the IC card (col. 22, lines 16-18) and the interface section is the only interface the IC card, it follows that it is inherently required the interface section receives the converted IC card command from the IC card RW apparatus and gives the converted IC card command to the IC card.*

7. **As per claim 2**, Tanaka discloses the second control unit performs interface conversion on data sent from the IC chip and stores the converted data in a predetermined storage area (col. 14, lines 25-29; Fig. 4, element 22D); *It should be noted the "card maker identification" is analogous to "data" and the "card maker identification information transfer section" is analogous to the "predetermined storage area."*

and the first control unit reads the data stored in the storage area in accordance with a control command for the storage device from the information processing apparatus and gives the read data to the information processing apparatus (col. 14, lines 30-34 and 58-62; col. 27, lines 23-28; Fig. 56A).

8. **As per claims 3 and 6**, Tanaka discloses first control unit receives a writing command for the storage device, in whose data area a control command for the IC chip is mapped, and extracts the control command for the IC chip mapped in the data area (col. 21, line 66 – col. 22, line 18). *It should be noted that any IC card command the RW apparatus converts is inherently required to contain a control command mapped*

for the IC card. If there was no control command mapped for the IC card within the R/W command then the R/W would not be able to access any data within the IC card.

9. **As per claim 4**, Tanaka discloses the first control unit refers to an address area of the writing command for the storage device and, when an address is set therein which shows that the control command for the IC chip is mapped in the data area, extracts the control command for the IC chip from the data area (col. 21, line 66 – col. 22, line 18). *It should be noted that the “entry names” within the “entry table” are analogous to “addresses.” It should also be noted that it is inherently required the IC card command contain an area for the specific card maker identification (i.e. entry name) for which the command is targeted.*

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claim 5** is rejected under 35 U.S.C. 103(a) as being obvious over Tanaka in view of Nagamasa et al. (U.S. Patent Application Publication 2004/0177215).

12. Tanaka discloses all the limitations of claim 1 except the IC chip comprises a nonvolatile memory and has a security function.

Nagamasa discloses the IC chip comprises a nonvolatile memory and has a security function (paragraph 0067, lines 29-32; paragraph 0042, lines 6-12 and 37-41; Fig. 22, element 150).

Tanaka and Nagamasa are analogous art because they are from the same field of endeavor, that being IC cards.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Nagamasa's IC chip with nonvolatile memory and security processing function within Tanaka's IC card reading/writing apparatus.

The motivation for doing so would have been to provide a storage apparatus in which security is improved (Nagamasa, paragraph 008).

Therefore, it would have been obvious to combine Tanaka and Nagamasa for the benefit of obtaining the invention as specified in claim 5.

Response to Arguments

13. Applicant's arguments filed November 16, 2006 with respect to claims 1-6 have been fully considered but they are not persuasive.

14. With respect to Applicant's argument beginning in the fourth paragraph of page 6 of the communication filed November 16, 2006, the recitation "detachably attachable" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process

steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

15. With respect to Applicant's argument in the first full paragraph of page 7 of the communication filed November 16, 2006, the Examiner respectfully disagrees and directs Applicant to the rejection of claim 1 above. Tanaka discloses the IC card processing section within the RW apparatus (i.e. first control unit) receives an IC card command (i.e. control command) from the host (i.e. information processing apparatus) and performs communication protocol conversion. Then the IC card processing section transmits a new IC card command in accordance with the converted communication protocol (i.e. extracted control command) to the IC card. Thus, it is clear that the IC card processing "extracts" a new IC card command from the original IC card command as a result of the communication protocol conversion. Accordingly, Tanaka sufficiently discloses the RW apparatus extracts a control command for the storage device from the information processing apparatus.

16. With respect to Applicant's argument in the second full paragraph of page 8 of the communication filed November 16, 2006, the Examiner respectfully disagrees and asserts that improving security within a storage apparatus is indeed a proper motivation to combine references. The Examiner asserts that practitioners in the art would have been motivated to combine Tanaka and Nagamasa in order to improve security within the storage apparatus which, the Applicant themselves admit, presents a benefit. Also, the Examiner directs Applicant to the fourth paragraph of section 20 in the Office action

dated June 16, 2006 as well as the fourth paragraph of section 12 in the current Office action regarding the manner in which the two references should be combined.

Accordingly, the motivation to combine the references is sufficient to justify the combination.

17. As for Applicant's arguments with respect to the dependent claims, the arguments rely on the allegation that independent claim 1 is allowable and therefore for the same reasons the dependent claims are allowable. However, as addressed above, independent claim 1 is not allowable, thus, Applicant's arguments with respect to the dependent claims are not persuasive.

Conclusion

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by MPEP 707.70(i):

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, **claims 1-6** have received a second action on the merits and are subject of a second action final.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

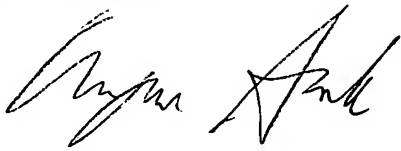
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arpan P. Savla whose telephone number is (571) 272-1077. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2185



Arpan Savla
Art Unit 2185
January 24, 2007



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